REMARKS

Reconsideration of the rejections set forth in the Office Action mailed September 25, 2003, is respectfully requested. Claims 4, 5, and 13-32 have been canceled without prejudice. Claims 1-3, 6-10, and 12 remain pending in this case.

Elections/Restrictions

In accordance with the provisional election made by John Kappos on September 18, 2003 over the telephone, Applicants hereby elect Group I, species (b), claims 1-10 and 12, with traverse.

Information Disclosure Statement

Attached for the examiner's convenience is a copy of the Katz et al. reference. Applicants respectfully request that the examiner initial and return the PTO Form 1449 after the Katz reference has been considered.

Interference

The Examiner has requested that Applicants specifically apply each limitation or element of each of the copied claim(s) to the disclosure of the application pursuant to 37 CFR 1.607(a)(5). Support in the current specification and in U.S. Patent 6,231,544, to which the current application claims priority and which was incorporated by reference in its entirety, is provided below.

1. (Original) A catheter apparatus for use in a body passage, comprising:

a catheter shaft; **[page 19, lines 2-8; page 19, line 19 – page 20, line 4; and Figs. 6-13 of the current specification] [Fig. 27 and Col. 29, lines 35-50 of USP 6,231,544]**

an expandable conduit defined by a filter mesh material of varying porosity mounted on said catheter shaft, said expandable conduit having an upstream end and a downstream end, said expandable conduit having a collapsed position in which said expandable conduit is collapsed toward said catheter shaft and an expanded position in which said upstream end of said expandable conduit is open to fluid flow; and **[page 16, lines 6-18; page 17, lines 12-23; page 18, line 20 – page 20, line 2 of the current specification] [Col 13, line 49 – Col 14, line 3 and Col. 35, lines 36-39 of USP 6,231,544]**

an upstream sealing member at said upstream end of said expandable conduit for creating a seal between said upstream end of said expandable conduit and an internal wall of the body passage. **[page 16, line 19 – page 17, line 3 and page 20, lines 6-9 of the current specification; and Col. 17, lines 9-56 and Col. 35, lines 36-39 of USP 6,231,544]**

2. (Original) The catheter apparatus of claim 1, wherein said upstream sealing member comprises an inflatable toroidal balloon. **[Col. 17, lines 9-56 and Col. 35, lines 36-39 of USP 6,231,544]**

3. (Original) The catheter apparatus of claim 1, further comprising a perfusion lumen within said catheter shaft in fluid communication with a space exterior to said expandable conduit. **[Figs. 6-8 and page 19, line 3 – page 20, line 11 illustrate a lumen in intravascular**

catheter 110 of the current specification] [Col. 16, line 44 – Col. 17, line 8 and Col. 35, lines 36-39 of USP 6,231,544]

6. (Original) The catheter apparatus of claim 1, further comprising an occlusion member for selectively occluding said expandable conduit. **[Figs. 4-6, Col. 20, line 50 – Col. 21, line 34, and Col. 35, lines 36-39 of USP 6,231,544]**

7. (Original) The catheter apparatus of claim 6, further comprising an infusion lumen within said catheter shaft having an infusion port upstream of said occlusion member. **[Fig. 29, Col. 29, line 63 – Col. 30, line 18, and Col. 35, lines 36-39 of USP 6,231,544]**

8. (Original) The catheter apparatus of claim 7, further comprising a second perfusion lumen within said catheter shaft. **[Fig. 29, Col. 29, line 63 – Col. 30, line 18, and Col. 35, lines 36-39 of USP 6,231,544]**

9. (Original) The catheter apparatus of claim 1, further comprising a tubular sheath sized to fit over said expandable conduit when in said collapsed position. **[Fig. 8 and page 19, lines 7-13 of the current specification] [Figs. 16-17; Col. 25, line 49 – Col. 26, line 55; and Col. 35, lines 36-39 of USP 6,231,544]**

10. (Original) The catheter apparatus of claim 6, wherein said occlusion member is an inflatable occlusion balloon. **[Figs. 4-6, Col. 20, line 50 – Col. 21, line 34, and Col. 35, lines 36-39 of USP 6,231,544]**

12. (Original) The catheter apparatus of claim 1, wherein said catheter shaft is positioned internal to said expandable conduit. **[Figs. 6-8 and page 19, lines 7-13 of the current specification]**

The examiner has alleged that the effective filing date of the application is more than 3 months after the effective filing date of USP 6,254,563, which was filed on March 20, 2000, and which claims priority to a provisional application filed on December 15, 1997. This application was filed on February 15, 2002 and is a continuation of U.S. Application Serial No. 09/642,570, filed August 17, 2000, which is a continuation of U.S. Application Serial No. 08/996,532, filed December 23, 1997, now U.S. Patent No. 6,258,120. In addition, this application also claims priority to U.S. Application Serial No. 08/854,806, filed May 12, 1997, now U.S. Patent No. 6,231,544. Therefore, Applicants respectfully assert that the effective filing date of this application is not more than 3 months after the effective filing date of USP 6,254,563, and therefore, 37 CFR 1.608(b) does not apply. To the extent an affidavit or Declaration is still deemed necessary, Applicants enclose herewith a copy of the Declaration of the inventors stating the claim of priority to an effective filing date of May 12, 1997.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because Fig. 5 includes reference number 220, which is not mentioned in the specification. Applicants submit herewith a replacement sheet of Fig. 5, which does not contain reference number 220.

Specification

The abstract was objected to for containing the legal phraseology "said" on line 2. Applicants have amended the abstract to refer to "the catheter shaft."

As requested, Applicants have amended page 22, line 13 to recited "cannula 230."

As requested, Applicants have added a brief description of Fig. 24B.

The specification is objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter. Claim 1 has been objected to as allegedly failing to support a "filter mesh of varying porosity." Applicants respectfully assert that support for this limitation can be found in U.S. Application Serial No. 08/854,806, now issued as U.S. Patent no. 6,231,544, which was the priority application and was incorporated by reference in its entirety. (See page 1, lines 1-11 of the current specification). In the '544 patent, varying pore sizes are called out in the '544 specification, e.g., "50-300 μm, more preferably 57-285 μm, more preferably 64-270 μm, more preferably 71-255 μm, more preferably 78-240 μm, more preferably 85-225 μm, more preferably 92-210 μm, more preferably 99-195 μm, more preferably 106-180 μm, more preferably 103-165 μm, more preferably 120-150 μm." (Col. 13, lines 59-64).

Antecedent basis in the specification for the "upstream sealing member comprises an inflatable toroidal balloon" (claim 2) can be found in Col. 17, lines 9-56 and Col. 35, lines 36-39 of USP 6,231,544, which was incorporated by reference in its entirety.

Antecedent basis in the specification for "a perfusion lumen within said catheter shaft in fluid communication with a space exterior to said expandable conduit" (claim 3) can be found in Figs. 6-8 and page 19, line 3 – page 20, line 11 illustrate a lumen in intravascular catheter 110 of the current specification. In addition, antecedent basis can be found in Col. 16, line 44 – Col. 17, line 8 and Col. 35, lines 36-39 of USP 6,231,544.

Claims 4 and 5 have been canceled without prejudice, although we believe that these are obvious variations of the embodiments claimed in the currently pending claims.

Antecedent basis in the specification for "an occlusion member for selectively occluding said expandable member" (claim 6) can be found in Figs. 4-6, Col. 20, line 50 – col. 21, line 34, and Col. 35, lines 36-39 of USP 6,231,544.

Antecedent basis in the specification for "an infusion lumen within said catheter shaft having an infusion port upstream of said occlusion member" (claim 7) can be found in Fig. 29, Col. 29, line 63 – Col. 30, line 18, and Col. 35, lines 36-39 of USP 6,231,544.

Antecedent basis in the specification for "a second perfusion lumen within said catheter shaft" (claim 8) can be found in Fig. 29, Col. 29, line 63 – Col. 30, line 18, and Col. 35, lines 36-39 of USP 6,231,544.

Antecedent basis in the specification for "said occlusion member being an inflatable occlusion balloon" (claim 108) can be found in Figs. 4-6, Col. 20, line 50 – col. 21, line 34, and Col. 35, lines 36-39 of USP 6,231,544.

Art Rejections

Claims 1-10 and 12 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Macoviak et al. (USP 6,139,517). As stated above, claims 1-10 are entitled to an effective filing date of May 12, 1997. Therefore, the '517 patent, which issued on October 31, 2000 and claims priority to a provisional application filed on December 15, 1997, is not prior art. With respect to claim 12, the effective filing date is December 23, 1997, eight days after the December 15, 1997 filing of the provisional application by Macoviak. Applicants assert that Macoviak is not prior art to claim 12, and this fact will be established during the proposed interference.

Therefore, Applicants respectfully request withdrawal of the rejections and reconsideration of the pending claims.

Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicants' undersigned representative at (949) 737-2900. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,
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